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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,185	06/30/2003	Naoto Ohshima	Q76207	8782
23373	7590	12/15/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			LETSCHER, GERALDINE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/608,185	Applicant(s) OHSHIMA ET AL.	
	Examiner Geraldine V Letscher	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 17-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 16 is/are rejected.
- 7) ☒ Claim(s) 10-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9-22-03 & 11-1-04</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election without traverse of Group II, claims 7-16, in the reply filed on November 1, 2004 is acknowledged.
2. Claims 1-6 and 17-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 1, 2004.
3. Claims 7-16 are presently under consideration.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being obvious over either Aiba et al. (U.S. Patent No. 6,727,054) or Aiba et al. (U.S. Patent No. 6,706,468) in view of Inagaki (U.S. Patent No. 5,162,195).

Each of Aiba et al. ('054) and ('468) disclose a silver halide photographic light-sensitive material comprising a support having thereon at least one silver halide emulsion layer containing a silver halide emulsion having a silver chloride content of at least 90 mole% (respectively: abstract and column 2, line 28; abstract and column 2, line 23), and at least one iridium metal complex compound inclusive of the instant

Art Unit: 1752

formula (I) (respectively: column 10, line 24; column 6, line 53). Each of the light-sensitive silver halide emulsion layers may contain plural layers sensitive to the same spectral region (respectively: column 20, line 14; column 16, line 24 and column 20, line 65). The photographic advantages derived from the use of high chloride content emulsions is well known in the photographic art, and is also illustrated in each of Aiba et al. ('054) and ('468). The use thereof a high chloride content silver halide emulsion in three layers having different sensitivities is illustrated I Inagaki et al. (column 3, line 55). It would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to utilize the high chloride content emulsion in more than one light-sensitive silver halide emulsion layer having different sensitivities as generally disclosed therein each of Aiba et al. ('054) and ('468), and more specifically as taught in Inagaki et al., with reasonable expectations of achieving, absent object evidence to the contrary, the advantages taught therein as well as those associated with the use of a high chloride content silver halide emulsion in more than one layer with each having a different sensitivity.

NOTE: The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not

claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

6. Claims 7-9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mydlarz et al. (U.S. Patent No. 5,783,378) in view of Inagaki (U.S. Patent No. 5,162,195).

Mydlarz et al. discloses a silver halide photographic light-sensitive material comprising a support having thereon at least one silver halide emulsion layer containing a silver halide emulsion having a silver chloride content of at least 90 mole% (column 13, line 35), at least one class (i) dopant represented by formula (I) (column 5, line 1) inclusive of the iridium metal complex compound of the instant formula (II), and at least one class (iii) dopant (column 13, line 6) inclusive of the metal complex of the instant formula (I). The photographic advantage derived from the use of high chloride content emulsions is well known in the photographic art. The use thereof a high chloride content silver halide emulsion in three layers having different sensitivities is illustrated I Inagaki

et al. (column 3, line 55). It would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to utilize the high chloride content emulsion in more than one light-sensitive silver halide emulsion layer having different sensitivities as taught in Inagaki et al., in more than one light-sensitive silver halide emulsion layer having different sensitivities of Mydlarz et al., with reasonable expectations of achieving, absent object evidence to the contrary, the advantages taught therein as well as those associated with the use of a high chloride content silver halide emulsion in more than one layer with each having a different sensitivity.

Claim Objections

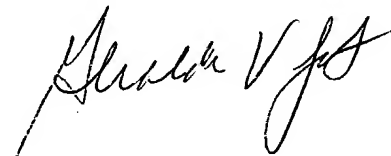
7. Claims 10-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. While the prior art teaches the metal complex compounds of the instant formulae (I) and (II), said art does not, in fact, teach or disclose utilizing different amounts of said compounds in more than one light-sensitive silver halide emulsion layer having different sensitivities from each other, as required by the instant claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldine V Letscher whose telephone number is (571) 272-1334. The examiner can normally be reached on 7:30am to 4:00pm.

Art Unit: 1752

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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